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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/817,245  | 03/27/2001  | Naoaki Horiuchi      | 041465-5104         | 8060             |
| 9629  | 7590        | 01/20/2006           | EXAMINER            |                  |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      | ABEL JALIL, NEVEEN  |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 2165                 |                     |                  |

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/817,245             | HORIUCHI ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Neveen Abel-Jalil      | 2165                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11/15/2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Remarks***

1. In response to Request for Reconsideration filed on November-15-2005, claims 1-20 are presently pending in the application.
2. The Amended abstract and specification received on June 16, 2004 is entered and acknowledged.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 10-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cluts (U.S. Patent No. 5,616,876).

Cluts discloses:

As to claims 1 and 11,

an AV information accumulating device for accumulating AV (Audio Visual) information, which include any one of audio information, video information and data

information associated with at least any one of the audio information and the video information;  
See 4:36-67;

a characteristic information accumulating device for accumulating characteristic information, which defines said accumulated AV information, for said each AV information; See 11:32-47;

an inputting device for inputting search characteristic information defining said accumulated AV information required to be searched; See 11:34-67; 12:55-67;

an example inputting device for inputting example information to illustrate said AV information having a characteristic indicated by the search characteristic information when said inputted search characteristic information is not included in said accumulated characteristic information; See 11:61-67; 14:1-27;

an extracting device for extracting example characteristic information being said characteristic information, which defines said inputted example information, from said example information; See 14: 28-67; and

an outputting device for searching said AV information associated with said extracted example characteristic information in said AV accumulating device and outputting said searched AV information to an exterior as said AV information associated with said search characteristic information; See 14:27-67.

As to claims 2 and 12,

a corresponding information accumulating device for forming a corresponding information, which associates said extracted example characteristic information to said inputted

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search characteristic information and storing said formed corresponding information; See 16:40-67; and

a search device for searching said example characteristic information from said characteristic information accumulating device on the basis of said accumulated corresponding information when said search characteristic information is inputted again after said corresponding information is accumulated in said corresponding information accumulating device; See 16:40-67;

wherein said outputting device searches said AV information associated with said searched example characteristic information from said AV accumulating device when said search characteristic information is inputted again and said outputting device outputs said searched AV information to an exterior as said AV information associated with said search characteristic information; See 16:40-67.

As to claims 3 and 13,

wherein said example inputting device is used for inputting said different and plural example information and said extracting device extracts said example characteristic information, which is common among said inputted plural example information, from each of said example information.; See 16:40-67

As to claims 4 and 14,

wherein said example inputting device is used for inputting said different and plural example information and said extracting device extracts said example characteristic information,

which is common among said inputted plural example information, from each of said example information; See 16:40-67.

As to claims 5 and 15,

wherein said outputting device outputs said AV information associated with said extracted example characteristic information to an exterior as said AV information associated with said search characteristic information by using at least any one of a sound and an image; See 4:50-64.

As to claims 6 and 16,

wherein said outputting device outputs said AV information associated with said extracted example characteristic information to an exterior as said AV information associated with said search characteristic information by using at least any one of a sound and an image; See 4:50-64.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cluts (U.S. Patent No. 5,616,876).

Cluts discloses the claimed invention except for wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice since it was known in the art that using a voice with a speech to text translator would enable a user to convert his voice to be used as input to activate a computer to perform a common function such as searching for data that would allow the user the freedom of not having to use a keyboard to enter information into the computer for a response.

*Response to Arguments*

7. Applicant's arguments filed on November 15, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that “Cluts's features do not teach or suggest or meet the extracting device of the claimed invention” is fully considered but not persuasive.

Cluts explicitly teaches in column 20, lines 12-20 that the style EQ feature allows the subscriber to alter the mix of the songs that are played from the playlist by adjusting one or more of the indicators. Thus, if the subscriber does not care for one of the styles in the playlist, the subscriber can decrease the amount of that style that is played. Similarly, the subscriber can boost the styles of music that he or she enjoys, which acts as a filter and does not alter the actual content of the playlist.

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The Examiner interprets the adjusting an indicator as a inputted example information of the playlist which is interpreted to be the example information. “Extracting” is interpreted to be “filtering”. Therefore, the above paragraph from Cults teaches by changing (i.e. input) styles (i.e. characteristics information) of a playlist (i.e. deemed to include example information) using a filter (i.e. extracting) broadly read on the argued limitaion.

In response to applicant’s argument that “Cults’s features do not teach or suggest or meet the example inputting device of the claimed invention which operates differently in that when inputted search characteristics information is not included in the accumulated characteristic information” is fully considered but not persuasive.

Applicant agrees in the response on page 3, lines 4-6 that “more like function of Cults is utilized for identifying additional music that is similar to the user’s current selection (Cults col. 4, lines 49-51); which is precisely indicating to the Examiner that there’s no additional input performed by the user for receiving additional similar “example” content. Cults in column 21, lines 26-42, teaches that the system (i.e. server) defines, maintains, and provides the “more like” feature content implying that no added input is needed by the user. Therefore, reads on the argued limitaion.

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., example inputting device operates on the premise that a selection by the user has not been successfully completed) are not recited in the rejected claim(s). Although the claims are interpreted in light

of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant contends in the response on page 3 that the example inputting device of the claimed invention operates differently as shown in the disclosure which is not found in the claims.

In response to applicant's argument on page 4 that “Cults's features do not teach or suggest or meet the example inputting device of the claimed invention which operates differently in that the user determines the example information”

Firstly, no where in the independent claim does the user perform the input. Secondly, the entire disclosure of Cults teaches a user inputting information (Cults col. 3, line 7). Thirdly, the type of information (i.e. example or not) inputted is not given patentable weight; information is merely data which can defined as anything and everything. Cults col. 3, lines 10-16, teaches the system providing a list of proposed new programming in response to a second input signal which is read on “example information”.

Furthermore, the Applicant agrees in the response on page 4, lines 1-3 that “Cults example information is predetermined in advance”; which is precisely as the claim language since the characteristics are first indicated by the search characteristic information previously inputted as disclosed in the proceeding limitaion of the Independent claims. Therefore, reads on the argued limitaion.

***Conclusion***

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

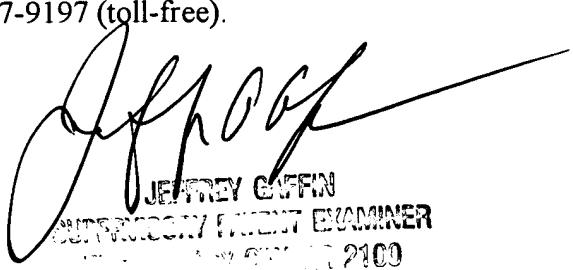
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
January 12, 2006



JEFFREY GIFFIN  
USPTO PATENT EXAMINER  
ART UNIT 2165, 2100